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TECHNOPROP COLTON, L.L.C.
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In re Application of
Mayerson et al.
Application No. 10/056,490
Filed: January 24, 2002
Attorney Docket No. 14690.002USB

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OFFICE OF PETITIONS
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DECISION ON PETITION
:
UNDER 37 CFR 1.182
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This is a decision on the petition under 37 CFR 1.182 filed May 14, 2004, which is being treated as a request for clarification of appropriate governing rules in this application.

So construed, the petition is **granted to the extent indicated.**

Petitioner notes that, as filed on January 24, 2002, the instant application specification at page 1 line 1 contained the following claim for benefit under 35 U.S.C. § 120:

The present application is a continuation of US patent application no. 09/694404 filed on 23 October 2000, currently pending, which is a continuation-in-part of US patent application no. 09/3482000, filed on 6 July 1999, abandoned.

Petitioner complains that it was not until the first office action of May 6, 2003, which is later than the intervals permitted by 37 CFR 1.78(a)(2) (i.e., 4 months from the instant filing date, or 16 months from the filing date of the prior provisional application from which benefit is claimed) that the examiner objected to the above-stated relationship to prior nonprovisional application no. 09/694,404 as that of "continuation," and required an amendment to the priority claim indicating that the specific relationship is that of "continuation-in-part."

Petitioner disagrees with the examiner's statement of the specific relationship *per se*, complains that the examiner has refused entry of his imposed required amendment in the absence of a petition and fee under 37 CFR 1.78, and, in any event, petitioner contends that since a reference to each prior application was present on filing, the timing requirements of 37 CFR 1.78 have been met such that a petition and fee under 37 CFR 1.78 are not now required. Petitioner thus poses the question: whether the timing requirements of 37 CFR 1.78(a)(2) should be applied under the facts of this case.

Petitioner is advised that by its terms, 37 CFR 1.182 only applies when no other rule(s) provides for the question. As to the underlying question as to whether the examiner is correct in objecting to applicant's initial denomination of the specific relationship between the instant application and

prior nonprovisional 09/699,404 as being that of a continuation as opposed to continuation-in-part, 37 CFR 1.181(a) specifically provides for review of the examiner's objection and requirement, as such is not a matter subject to appeal. See MPEP 1002.03(c), ¶ 3, which indicates that the examiner's Group Director is the first level deciding official for review of any contested objection or requirement of the examiner. Since the regulations at 37 CFR 1.181(a)(3) and procedures of the USPTO at MPEP 1002.02(c) specifically provide for any review of the examiner's objection and requirement, the issue will not be further addressed herein under 37 CFR 1.182.¹

It should be noted that under the amendments to the statute provided by the American Inventor's Protection Act, § 120 was amended to state that the Director could consider an applicant's failure to timely supply the "specific reference" to a prior application to be a waiver of the right to claim benefit, unless remedied by USPTO acceptance of an unintentionally delayed amendment and surcharge. The USPTO has construed the "specific reference" to include (1) the identification of the prior nonprovisional application, and (2) an indication of the relationship between the prior and subsequent applications, and has set the time periods to be the later of either 4 months from the filing date of the later application, or 16 months from the filing date of the prior application. See 37 CFR 1.78(a)(2).

As to whether the time periods of 37 CFR 1.78(a)(2) should be applied under the present circumstances, the USPTO has also taken the position that the time periods of the regulation do apply to adding, or correcting, a benefit claim after filing. See the notice "Claiming the benefit of a prior-filed application under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)," 1268 *Off. Gaz. Pat. Off.*, 89, (March 18, 2003) (copy enclosed), Part V, under the caption "Correcting or Adding a benefit claim after filing:"

Any request for a corrected filing receipt to include a corrected or added benefit claim must be submitted within the time period required by 37 CFR 1.78(a) and be accompanied by an amendment to the specification, or an application data sheet.

Since the circumstance described herein involves a correction to the specific reference (i.e., continuation, divisional or continuation-in-part) to the prior non-provisional application, the time periods of 37 CFR 1.78 do apply. Id. It is noted that the "specific reference" required of a benefit claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) must include identification of, and the relationship between the involved applications. Further, the above-identified notice also indicates that the specific relationship (i.e., whether a given application is a continuation, divisional, or continuation-in-part of a prior application) involves mutually exclusive terms. Thus, the as-filed indication in the specification that the specific relationship was that of

¹37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (Comm'r Pat. 1903).

continuation, is mutually exclusive of, and is, therefore, not the same relationship as, the continuation-in-part relationship that was admittedly not presented within the time limit of 37 CFR 1.78(a)(2). See id. under the caption "Examples:"

As stated previously, to specify the relationship between the nonprovisional applications, applicant must specify whether the subject application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. Note that the terms are exclusive. An application cannot be, for example, both a continuation and a divisional, or a continuation and a continuation-in-part, of the same parent application.

It follows that the contention that the as-filed specified relationship of continuation tolled the filing period and fulfilled the other requirements of 37 CFR 1.78 such that the later specified--but mutually exclusive-- relationship of continuation-in-part may be made in the absence of a petition and surcharge under the rule, must fall. The notice also indicates that promptly specifying the correct specific relationship is important, in that the nonprovisional application may be published with incorrect information:

the designation of an application as a continuation (rather than as a continuation-in-part) is an indication that the entire invention claimed in an application has support in the prior application, whereas the designation of an application as a continuation-in-part is an indication that the claimed invention is not entirely supported by the prior application. Thus, the specific relationship between nonprovisional applications in a chain of benefit claims and the indication of the specific nonprovisional application(s) that is directly claiming the benefit of a provisional application, will provide the information that is needed by examiners and the public in order to determine the effective prior art date of the application publication, or patent, under 35 U.S.C. 102(e).

See id. under the caption "Statement of the Problem: Background."² To the extent that 37 CFR 1.182 is here applicable to the issue as stated by petitioner, the timing requirements of 37 CFR 1.78(a) do apply and control the issue. Since the timing requirements of 37 CFR 1.78(a) here govern, 37 CFR 1.182 may not be used to obviate those requirements.

Should applicant wish to present a petition under 37 CFR 1.78, a petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is applicable to those applications, as here, filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii), as here. In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

² It is noted that the above-identified non-provisional application was published on 09/26/2002 as US20020137902A1, with the as-filed specified relationships.

- (1) the specific reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Lastly, the request for refund of the petition fee required for a petition under 37 CFR 1.182 is declined. The fee was owed on the filing of the petition under the terms of the rule, regardless of the outcome of this decision.

Any forthcoming petition under 37 CFR 1.78 should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Window located at:

 2011 South Clark Place
 Crystal Plaza Two Lobby
 Room 1B03
 Arlington, VA 22202

By fax: (703) 872-9306
 ATTN: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3217.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT : copy of 1268 O.G. 89 (March 18, 2003)